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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,822	04/06/2006	Philip Bunce	039550154USWO	3654
23552	7590	07/03/2008		
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			EXAMINER PATEL, SHEFALI DILIP	
			ART UNIT 3767	PAPER NUMBER
			MAIL DATE 07/03/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/574,822	<b>Applicant(s)</b> BUNCE, PHILIP	
	<b>Examiner</b> SHEFALI D. PATEL	<b>Art Unit</b> 3767	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 17 and 19-24 is/are rejected.
- 7) ☒ Claim(s) 15, 16 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file: AU 2003905449, filed in Australia on October 6, 2003.

### *Oath/Declaration*

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

Signature of inventor Philip Bunce is missing.

### *Specification*

3. The abstract of the disclosure is objected to because of the use of the term "indexing **means**" and the last sentence of the abstract is missing a period “.”:

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. **The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.** The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Correction is required. See MPEP § 608.01(b).

*Claim Objections*

4. Claims 3-5, 8-18, and 20-22 are objected to because of the following informalities:

In regards to claims 3-5, 8-18, and 20-22, the preamble states "An inoculation means"; however said claims are dependent claims which depend upon respective independent claims in which the preamble states "An inoculation device". To be consistent with the independent claims, the preambles, for all claims objected to, should be changed to "An inoculation device".

In regards to claim 12, on page 8, line 9, a comma "," is needed between "within the fixed portion" and "an indexing means" to distinguish the two limitations.

In regards to claim 15, the limitation "is provided with a an at least" should be corrected as "is provided with an at least".

Appropriate correction is required.

5. Claim 16 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In regards to claim 16, the claim states the limitation that the "aperture is part annular"; however, in claim 15, which claim 16 is dependent on, the claim states the limitation "at least partially annular aperture". Claim 16 does not further limit the subject matter of claim 15.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-7, 10, 11, 17, and 19-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In regards to claims 1-7, 10, 11, 17, and 19-24, the claims state an "indexing means" which was not described in the specification distinctly enough to identify Applicant's structure of said "indexing means": When an element is claimed using language falling under the scope of 35 U.S.C. 112, 6th paragraph (often broadly referred to as means or step plus function language), the specification must be consulted to determine the structure, material, or acts corresponding to the function recited in the claim. *In re Donaldson, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994) (see MPEP § 2181- § 2186)*. In other words, Applicant has not stated in the specification distinctly what the structure of the "indexing means" is.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3771

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-9, 11-14, and 19-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Cohen (US 7,361,163).

In regards to claims 1-7, 12, 13, 19-24, Cohen teaches a device (Figures 1A-2B and 9, fluid transfer device [100]) comprising:

- a. a body having a fixed portion (shaft [116]) and a moveable portion (cartridge [102])
- b. said fixed portion [116] comprising a substantially cylindrical body having a front face (Figure 1A)
- c. the moveable portion [102] being slidably (Figure 1A to 1B) and rotatably within the body (column 4, lines 55-59)
- d. a needle (needle [114]) supported from the movable portion [102] to be moveable longitudinally on relative movement of the movable portion with respect to the fixed portion, towards and away from the front face whereby the free end of the needle is caused to undergo a longitudinal movement between a retracted position at which the free end of the needle lies rearward of the front face (Figure 2A) and an extended position at which the free end of the needle extends forward of the front face (Figure 2B) (column 4, lines 25-31)
- e. the needle [114] being supported such that its central axis is offset from the axis of rotation of the movable portion [102] within the fixed portion [116] (Figures 1A-2B)

f. an indexing means (pin [900] engages gear tooth [902]) provided between the moveable portion [102] and the fixed portion [116] to cause an indexing lateral movement of the needle in a direction transverse to the longitudinal movement about the axis of rotation (Figure 9) (column 4, lines 30-34)(column 7, lines 35-47)

g. in association with the longitudinal movement of the needle [114] wherein on each longitudinal movement the needle is located at a separate station (column 4, lines 30-34).

In regards to claims 2-7 and 19-24, with regards to such limitations as “the indexing means is **adapted to** cause the lateral movement”, for example, it has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

In regards to claim 13, with regards to the limitation “the moveable portion is **capable of** rotational movement”, it has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

In regards to claims 8 and 14, Cohen teaches that said front face of said fixed portion [116] is open based on a locking mechanism opening [104] on the fixed portion [116] for receiving the movable portion [102] (Figure 1A) (column 3, lines 64-67 to column 4, lines 1-3).

In regards to claim 9, Cohen teaches that said front face of said fixed portion [116] has an aperture of syringe element [210] which couples with and extends needle [114] to the extended position (Figures 2A-2B) (column 4, lines 46-50) Said needle [114] travels in a circular path

about the fixed portion [116] as the movable portion [102] is rotated (column 4, lines 30-34)(column 7, lines 35-47).

In regards to claim 11, Cohen teaches that the needle [114] occupies an initial position prior to undergoing any longitudinal movement at which the needle is retracted (Figure 1A) before the movable portion [102] is mounted to the fixed portion [116] (column 3, lines 64-67).

### ***Allowable Subject Matter***

10. Claims 10 and 15-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In regards to claim 10, Cohen, as a sole reference or in combination with other prior art references, does not provide a teaching for the indexing means causing the needle to move to a final station located beyond the path on completion of passage of the needle along the path.

In regards to claim 15, Cohen, as a sole reference or in combination with other prior art references, does not provide a teaching for the front face having an at least partially annular aperture. Claims 16-18 are dependent upon claim 15.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEFALI D. PATEL whose telephone number is (571) 270-3645. The examiner can normally be reached on Monday through Thursday from 8am-5pm Eastern time.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin C. Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shefali D Patel/  
Examiner, Art Unit 3767  
06/24/2008

/Justine R Yu/  
Supervisory Patent Examiner, Art Unit 3771